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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,463	12/05/2000	Werner Sievers	HOE97/F143	8152

7590

02/05/2003

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EXAMINER
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WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/05/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/730,463

Applicant(s)

SIEVERS ET AL.

Examiner

Katarzyna Wyrozebski Lee

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attachment to the Advisory.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 2.Claim(s) rejected: 1 and 3-19.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

EDWARD J. CAIN  
PRIMARY EXAMINER  
GROUP 1590



***Attachment to the Advisory***

The amendment filed on January 17, 2003, which is Amendment after Final, fails to set the application in condition for allowance for the reasons stated below. In addition, the Amendment after Final contains new independent claims, which would narrow the invention so that another search would have to be conducted.

Previously the independent claims of the applicant's invention required only method of making gel. New process claims also include steps that have limitation of using such gel in particular field. In order to have such claims added to the application, the applicant can file CPA or RCE which ever is appropriate.

***112/101 Rejection***

The applicant to this date has not removed the improper language from the claims. Although the applicant vigorously protests changing the language "use of", the examiner has to be reminded that language used in the claims is dictated by MPEP. The examiner has no authority to wave such rules and regulations. 101 rejection is applied per guidance from MPEP and according to these rules language "use of" is not a proper language. Claims will not be in condition for allowance unless such language is removed or change appropriately.

***Claim Rejections - 35 USC § 102***

The rejection over the prior art of Hammer as applied against present claims is not overcome. The rejection is therefore incorporated herein by reference.

The applicant argues that the prior art of Hummer does not disclose present invention because "...in Example 2 of Hammer et al, after mixing a perfluorinated ion exchange resin solution with a silicon containing solution, the solution was left to stand". The applicant further argued that the examiner did not provide evidence, that the process of Hammer would form gel. In addition the applicant has argued that although Hammer refers to its product as inorganic network, it does not state that the network is both organic and inorganic.

When looking at the Example 2, the examiner would like to point out that in citing the example 2, the applicant has missed an important step, which is addition of hydrochloric acid, wherein addition of acid will always inherently change the pH of the solution. The composition was gelled and stirred before it was allowed to stand. Change in the pH was the cause of the gel formation. Therefore, since process in the prior art of Hammer is the same, it is reasonable to expect that it will give the same product.

With respect to the network terminology of the prior art of Hammer, the examiner agrees that the silica forms inorganic network as it is stated in the prior art of Hammer. It is also examiners position, that organic component will also be part of the network, since it was present during the process and thereby will be part of the final product. Therefore presence of organic component in the network will inherently render it organic-inorganic.

***Claim Rejections - 35 USC § 103***

The rejection over the prior art of Hammer and Jansen as applied against present claims is not overcome and is incorporated here by reference.

The prior art of Hammer in view of Jansen is traversed. The applicants argued that the prior art of Jansen teaches xerogels and not aerogels. The Jansen does not teach the density of the aerogels and its use in interpenetrating networks. The examiner has not provided objective evidence, that the combination of Hammer and Jansen inherently discloses composition of the present invention. The two prior art disclosures are not properly combined and there is no motivation to combine the disclosure of Hammer and Jansen.

At first the examiner would like to point out that the rejection over the prior art of Hammer and Jansen is a 103 rejection not a 102 rejection. Therefore the examiner does not have to show any inherencies. The examiner has to provide obviousness statement.

The prior art of Hammer was discussed above.

In the very first line the prior art of Jansen discloses that although the xerogels and aerogels are not the same, they are related. Therefore it would have been obvious to make one or the other. In fact, the density of the gel obtained by the prior art of Jansen is exactly where the applicant wants his invention to be. Therefore it would have been obvious to make an aerogel having appropriate density from different starting materials.

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With respect to the improper combination of the prior art disclosures, the examiner disagrees. If one of ordinary skill in the art would take the process of Jansen in presence of a polymer disclosed in Hammer one would still obtain gel, absent unexpected results.

With respect to the combination of the prior art of Hammer, Jansen and Geiss, the examiner agrees with the applicant's arguments, that the prior art of Geiss utilizes preformed aerogels particles. In such situation formation of the interpenetrating network with the polymer component will not occur. However, this is not why the prior art of Geiss was utilized. The prior art of Geiss was utilized to show that once the gel is obtained the composition containing it can be molded into an insulation article. Therefore the obviousness lied not in the process of making but in the process of using already formed gel.

In view of the above the rejection over the prior art of Hammer, Jansen and Geiss is not overcome.

With respect to the prior art of Pekala, the examiner agrees that the prior art discloses only organic aerogel. Since the prior art of Pekala does not teach, suggests or make obvious why one of ordinary skill in the art would want to utilize combination of melamine-formaldehyde gel with silica, this prior art rejection is overcome.

With respect to the prior art of Mager, the examiner agrees that the prior art discloses organic-inorganic polymer materials based on polymers and metal oxides such as silica. The

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prior art refers to the composition as sol, which does not mean that the composition is a gel or that it will be gelled. The prior art of Mager is hereby overcome.

In the light of the above office action, it is examiner's position that if the applicant files for continuation of the prosecution, the additional claims will be entered. In addition, since claim 2 is objected to, incorporation of this claim into all the independent claims would render application allowable. In addition applicant has to comply with the 101 rejection. If the applicant does not want new claims and is willing to make suggested changes, the applicant is invited to an interview.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

KIWL  
January 30, 2003

EDWARD J. CAIN  
PRIMARY EXAMINER  
GROUP 1500

